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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/626,099 | 07/26/2000 | Li Xing | | 8236 |

7590 03/04/2004

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EXAMINER

ALLEN, MARIANNE P

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| ART UNIT | PAPER NUMBER |
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1631

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,099

Applicant(s)

XING ET AL.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-6 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/14/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 4/22/03 and 11/12/03 have been entered.

Claims 4-12 have been newly introduced.

Applicant is advised that while claims 1-3 were previously allowed, a request for continued examination requires examination of these claims. This is not discretionary on the part of the examiner; all claims are considered and evaluated.

Drawings

The drawings filed in this application are acceptable subject to correction of the informalities indicated on the "Notice of Draftsperson's Patent Drawing Review," PTO-948 mailed with the previous Notice of Allowability mailed 1/22/03. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Information Disclosure Statement

Applicant is again reminded of their duty to disclose and encouraged to file an information disclosure statement.

Claim Objections

Claims 7-9 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Other than minor changes in wording in the preamble, claim 7 appears to be a duplicate of claim 1. None of the steps set forth in the method appear to differ nor the final step of providing a predicted pK_a . The text of dependent claims 8-9 appears to duplicate claims 2-3. Applicant is requested to explain how the claims differ in scope. Should applicant believe that claims 7-9 differ in scope from claims 1-3, applicant must point to basis for whatever concept distinguishes claims 7-9 from claims 1-3 in the specification. It is noted that the claims 7-9 are newly presented claims and applicant did not point to the specification for basis.

Applicant is advised that should claims 4-6 be found allowable, claims 10-12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The text of dependent claims 10-12 appears to duplicate claims 4-6. Each set of claims depends upon duplicate claims for the reasons set forth above. Applicant is requested to explain how the claims differ in scope.

Claim Rejections - 35 USC § 112

Claims 4-6 and 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claims 4-6 and 10-12 have been newly introduced. No basis has been pointed to in the specification and none is apparent. In particular, Figure 2 indicates that C.3 sp³ and so forth listed in claims 4 and 10 are not ionizable groups but rather atom types. There does not appear to be contemplation of a method where one ionizable group is selected nor one from the group provided in claims 4 and 10.

Claims 4-6 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 10 are confusing in reciting "step 1.a" in the claims. It appears that this should be "step 1 a)" to use consistent notation.

Claims 4 and 10 are confusing in reciting "the ionizable group is selected from the group." Claims 1 and 7 make clear that each ionizable group on the molecule is evaluated. It is

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unclear if applicant intends these claims to embrace only molecules that possess one ionizable group limited to those named. Alternatively, applicant may have intended that the ionizable groups comprise any of those named. Finally, as set forth above in the new matter rejection, Figure 2 indicates that the named group are atom types not ionizable groups.

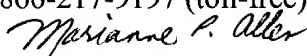
Conclusion

Claims 1-3 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa